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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,156	10/02/2003	Hiroshi Kurosawa	00862.022227.1	6709
5514	7590	10/22/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			FULLER, RODNEY EVAN	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2851	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/676,156

Applicant(s)

KUROSAWA, HIROSHI

Examiner

Rodney E Fuller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/858,964.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Rodney Fuller  
Primary Examiner



### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/2/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. The Preliminary Amendment, dated October 2, 2003, cancels claims 1-40 and adds 41-52. However, the original claims are from 1-42. Claim 41 depends from claim 1, and claim 42 depends from claim 41. Further, the applicant states that "Claims 41-52 are presented for consideration in lieu of claims 1-40." It is clear that there is a typographical error. Thus, the examiner has corrected the Preliminary Amendment (page 17) to cancel claims 1-42. The pending claims have been renumbered as noted below. Claims 43-54 are pending.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 41-52 have been renumbered as 43-54.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 43-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneko (US 6,028,659).

Kaneko discloses all the structure set forth in the claims. Regarding claim 43 (renumbered claim 41) and claim 49 (renumbered claim 47), Kaneko discloses an exposure system (column 1, line 5) which exposes the substrate (Fig. 1, ref.# 14) to the pattern (Fig. 1, ref.# 7) with respect to a unit region (Fig. 2, ref.# S1), to which the pattern is transferred, of the substrate; a determination system (column 5, lines 5-6) which determines whether a condition of an exposure performed by said exposure system is allowable during the exposure (abstract, lines 4; column 3, lines 17-19); and a control system (abstract, lines 4-6; column 3, lines 17-19; column 9, lines 65-67) which causes said exposure system to continue exposing a remaining region in the unit region of the substrate to the pattern, even after said determination system makes a negative determination for the unit region (abstract, lines 4-6; column 9, lines 65-67)."

Regarding claim 44 (renumbered claim 42) and claim 50 (renumbered claim 48), Kaneko discloses "wherein the condition of the exposure includes a position of a region of the substrate." (abstract, lines 9-10)

Regarding claim 45 (renumbered claim 43) and claim 51 (renumbered claim 49), Kaneko discloses "wherein the position is a position in a direction along which the pattern is projected." (abstract, lines 9-12)

Regarding claim 46 (renumbered claim 44) and claim 52 (renumbered claim 50), Kaneko discloses "wherein the condition of the exposure includes a precision of an exposure control performed by said exposure system." (column 5, lines 2-4)

Regarding claim 47 (renumbered claim 45) and claim 53 (renumbered claim 51), Kaneko discloses "wherein the precision of the exposure control includes at least one of an alignment sync control precision and an exposure amount control precision." (column 5, lines 2-4)

The method step of claim 48 (renumbered claim 46) and claim 54 (renumbered claim 52) are met by the operation of Kaneko as applied to claim 43 (renumbered claim 41) and claim 49 (renumbered claim 47).

Regarding claim 49 (renumbered claim 47), Kaneko discloses “a display system which discriminately displays the limit region, for which said determination system makes the negative determination, of the substrate.” (Fig. 1, ref.# 12 – is a controller such as a computer which would inherently include a display system)

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 43-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of U.S. Patent No. 6,657,703. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claim limitations are fully met by Kurosawa (US 6,657,703). As way of example, Claims 13 and 14 of Kurosawa (US 6,657,703) discloses the limitations of independent claims 43 (renumbered claim 41) and claim 49 (renumbered claim 47) wherein “an exposure system

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which exposes the substrate to the pattern with respect to a unit region, to which the pattern is transferred, of the substrate; a determination system which determines whether a condition of an exposure performed by said exposure system is allowable during the exposure; and a control system which causes said exposure system to continue exposing a remaining region in the unit region of the substrate to the pattern, even after said determination system makes a negative determination for the unit region.” (See Kurosawa US 6,657,703 – claim 13, lines 1-6; claim 14, lines 3-6)

The dependent claims are likewise fully met by Kurosawa (US 6,657,703).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yamada, et al. (US 4,996,640), Higashio, et al. (US 5,113,229), Ebihara, et al. (US 5,115,320) and Taniguchi (US 5,999,707) were not listed in the IDS but were considered in parent application 09/858,964.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney E Fuller whose telephone number is 571-272-2118. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rodney E Fuller  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'R. E. Fuller', is written over the typed name and title.

October 21, 2004